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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,576	08/30/2001	Sergio Stiberman	41693.010100	2548
54353	7590	11/02/2005	EXAMINER	
MANUEL VALCACL			AIRAPETIAN, MILA	
c/o GREENBERG TRAUIG, P.A.			ART UNIT	
1221 BRICKELL AVENUE			PAPER NUMBER	
MIAMI, FL 33131			3625	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/943,576		STIBERMAN, SERGIO	
	Examiner		Art Unit	
	Mila Airapetian		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/30/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment received on 07/18/2005 is acknowledged and entered.

The applicant has amended claims 1-17. Currently, claims 1-17 are pending for examination. Replacement drawing sheet received on 07/18/2005 is acknowledged and entered. The substitute specification received on 07/18/2005 is acknowledged and entered.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new grounds of rejection necessitated due to current amendments. This is a Final Rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-4, 6-11, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Joseph (US 2005/0165661).

Regarding Claim 1, Joseph teaches a method, apparatus and program product for facilitating transfer or vehicle leases comprising:

means for receiving used leased vehicle and existing lease agreement information submitted electronically by or on behalf of said current lessee and storing said information in a searchable database ([0042], [0043], [0046], Fig. 6 (102));

means for providing said used leased vehicle and existing lease agreement information electronically to prospective new lessees in response to electronic queries to said searchable database submitted by or on behalf of said prospective new lessees [0030];

means for said prospective new lessees to receive vehicle selection information submitted electronically by or on behalf of said current lessees ([0010], [0049], Fig. 5 (154));

means for notifying electronically said current lessees whose used leased vehicles are selected by prospective new lessees of said selection so that the parties can negotiate and complete a leased vehicle transfer transaction (Fig. 5 (144));

means for receiving and processing insurance application information submitted electronically by or on behalf of said current lessees or prospective new lessees with respect to vehicles selected by said prospective new lessees for insurance covering the current lessee's liability under the existing lease agreement for said vehicle in the event of lease default by the prospective new lessee after transfer of said vehicle and assignment of said lease agreement to said new lessee ([0047], Fig. 7 (244));

means for submitting said insurance application information to one or more insurers for application processing and approval [0050]; and

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means for arranging for vehicle and lease transfer and insurance document delivery, payment and vehicle delivery (Fig. 8 (292), "vehicle marked sold" would be inherent delivery.

Regarding Claim 2, said system wherein said means for receiving used vehicle and existing lease agreement information comprises a series of customized leased vehicle data entry screens made accessible to current lessees via a global computer network, whereby current lessees can create customized listings for their vehicles [0042].

Regarding Claim 3, said system wherein said means for notifying electronically current lessees whose used vehicles are selected by prospective current lessees of said selection further comprises messaging means current lessees and prospective new lessees to negotiate and complete a leased vehicle transfer transaction [0033], [0041].

Regarding Claim 4, said system wherein said messaging means comprises Internet e-mail communications protocols [0002].

Regarding Claim 6, said system further comprising means for prospective new lessees to submit their vehicle preferences for matching with leased vehicle data stored in said system's searchable database [0007], [0030].

Regarding Claim 7, said system further comprising means for prospective new lessees to submit their lease term preferences for matching with leased term data stored in said system's searchable database [0030].

Regarding Claim 8, said system further comprising means for notifying prospective new lessees of leased vehicle data stored on said system's searchable database that matches said prospective new lessee's leased preferences [0007], [0041].

Regarding Claim 9, said system further comprising means for notifying prospective new lessees of leased term data stored on said system's searchable database that matches said prospective new lessee's lease term preferences [0007], [0041].

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Regarding Claim 10, said system further comprising means for receiving lease assumption application information submitted electronically by or on behalf of prospective new lessees with respect to vehicles selected by said prospective new lessees for transfer of said leased vehicle [0031].

Regarding Claim 11, said system further comprising means for arranging for lease assumption document and delivery [0032].

Regarding Claim 16, said system further comprising means for receiving and processing prospective new lessee credit verification information [0032].

Regarding Claim 17, Claim 17 is rejected on the same rationale as set forth above in Claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of Murphy et al. US 2002/0052778 (hereinafter referred to as "Murphy").

Regarding Claim 12, Joseph teach all the limitations of claim 12 except that said system further comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees.

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Murphy teaches a system for providing incentives to purchasers wherein said system further comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees [0141].

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph to include that said system comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees, as disclosed in Murphy, in order to allow for interactive incentives within a dealership to force a consumer to work with a certain dealership [0032].

Regarding Claim 13, Joseph teaches said system further comprising means for current lessees to initiate communications with prospective new lessees that have accessed current lessee's vehicle and lease information stored on said system's searchable database prior to notification of vehicle selection by a prospective new lessee [0033].

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of Pecone (US 5513329).

Regarding Claim 14, Joseph teaches all the limitations of claim 14 except that said system further comprising means for prospective new lessees to purchase vehicle feature upgrades.

Pecone teaches a computer system to be upgraded at any time during the manufacture or in the field wherein the consumer need to purchase only the minimum computer system needed and, when ready for more features, purchase additional features (col. 2, lines 53-63).

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph to include that said system further comprising means for prospective new lessees to purchase vehicle feature

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upgrades, as disclosed in Pecone, because it would allow a customer to have a feature upgrades at a later date (col. 3, lines 15-19).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of DeWolf (US 2002/0032626).

Regarding Claim 15, Joseph teaches all the limitations of claim 15 except that said system further comprising means for prospective new lessees to purchase leased vehicle warranties/maintenance plans.

DeWolf teaches global asset information registry wherein various organizations such as manufacture, a dealer, an owner, a buyer, an insurance company, etc. may write data to and read data from the master record, including information about the vehicle, e.g. warranties [0102].

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph to include that said system further comprising means for prospective new lessees to purchase leased vehicle warranties/maintenance plans, as disclosed in DeWolf, because warranties ensure customers that they will receive a repair or replacement of the broken parts of the vehicle.

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over Joseph in view of official notice.

Regarding Claim 5, Joseph does not explicitly teach that said messaging means comprises instant peer-to-peer communications protocols.

However, examiner takes official notice of the concept and benefit of the notoriously well-known practice of peer-to-peer communication at the time of the applicant's invention. For example, using walkie-talkies is peer-to-peer. An important goal in peer-to-peer networks is that all clients provide resources, including storage space, and computing power. The distributed nature of peer-to-

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peer networks also increases robustness in case of failures by replicating data over multiple peers.

In view of the official notice, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph to include the feature that said messaging means comprises instant peer-to-peer communications protocols because in peer-to-peer networks clients directly communicate with another, as opposed to each client referring to a common server so peers can always find the data without relying on a centralized server.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) JP 406036101 to Fukaya discloses a system and method for renting a vehicle.

(ii) Richard Truett, Orlando Sentinel. Orlando, Fla.: Aug. 27, 1992, pg. G.1 discloses advantages of buying a lease auto.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mila Airapetian
Art Unit 3625
Examiner

MA

M.A.


J.C. GARCIA
PRIMARY EX